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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/411,576 09/22/89 MAGLICA

A 188167

EXAMINER

TUNG, M

ART UNIT

PAPER NUMBER

291

DATE MAILED:

12

07/18/91

LYON & LYON  
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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on 5/15/91 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.  | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input checked="" type="checkbox"/> <u>4 photoprints</u>                     |

Part II SUMMARY OF ACTION

1. ☒ Claims is \_\_\_\_\_ are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims is finally \_\_\_\_\_ are rejected.
5. ☒ Claims figure description is \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_ Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. The references listed on PTO-1449 submitted 5/15/91 have been considered by the examiner. Copies of these references are located in copending case 07/410965 and not in the instant case due to the large volume of material.
2. The documents listed by applicant in form PTO-1449 in regard to past litigation have been considered by the examiner, but are not deemed to be appropriate prior art for citation on a printed patent. Issues which are directed to utility or trademark have no bearing on the patentability of an ornamental design.
3. The new drawing submitted 5/29/91 does not gain the benefit of priority under 35 U.S.C. § 120 of parent cases 06/648032, 06/828729, 07/034918, 07/222378, and 07/356361 because in the new drawing, the head is still rounded and does not show a distinct contour that marks a definite change in plane.

Applicant asserts that the original Fig.8 flashlight does not show a contour which describes a definite change in plane. The examiner agrees that a specific contour line indicating a change in plane is not shown in Fig.8, but this is simply and obviously because the portion where it would be seen is cut-away. It remains the examiners position that Fig.8 does show a flashlight head with a definite change in plane, as seen from the cut-away view. (Note A on the attached photoprints.) In addition, the incomplete drawing of Fig.8 necessitates a reliance on the other figure views, namely, Figs.2 and 3 for a complete

disclosure. These two views do show a flashlight head with a distinct change in plane, contrary to the assertion by the applicant that Figs.2 and 3 show rounded heads. (Note B.)

Applicant also asserts that a "reasonable degree of precision" exists between the new drawings and the original informal drawings and that case law supports the allowance of mechanical drawing errors and inconsistencies. The examiner disagrees for two reasons. First, the change in shape of the flashlight head is not a simple mechanical drawing error, but a significant change in the overall shape. In the flashlight art, changes in the shape of the head are enough to distinguish one design from another. The importance of this change in shape is further reinforced by the fact that the applicant would easily gain the benefit of priority if the new drawings conformed to the disclosures of the parent applications by showing the flashlight with a contour line describing a distinct change in plane. Second, a determination of minor versus significant changes in the drawing are judged on a case by case basis, depending on the art and the specific claim.

4. The added phrase "candle mode" is questionable and must be removed from the Fig.1 description and the claim as described below. The title of the claimed design remains "miniature flashlight." 35 U.S.C. § 112 par. 2, 37 C.F.R. § 1.117.

5. For preferred form the description(s) of Fig(s). 1 must be

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amended to read:

--Fig.1 is a front, top perspective  
view of a miniature flashlight  
showing my new design;--

Correction is required. 35 USC § 112 par. 2, 37 CFR § 1.117.

6. For proper form (37 CFR 1.153), the claim must be amended to read: I claim: The ornamental design for a miniature flashlight as shown and described. Correction is required. 35 USC § 112 par. 2, 37 CFR § 1.117.

7. The claim is FINALLY rejected under 35 U.S.C. § 112 par.1 for new matter. The proposed additional or amended illustration has been entered, however said amendment introduces new matter (35 U.S.C. § 132, 37 C.F.R. § 1.118). Due to the differences between the original and new drawings, applicant's disclosure fails to comply with the description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, the claim is FINALLY rejected in that the disclosure does not satisfy the description requirement of 35 U.S.C. § 112, first paragraph. (In re Kaslow, 217 USPQ 1089 and In re Rasmussen, 211 USPQ 323.) The new matter is described as follows:

c) The candle end of the flashlight shows a partially uncovered light in the new drawing, but the original shows a completely covered light. Note C, Fig.1 on the attached photoprints of the new and original drawings.

d) The new drawing shows a proportionally wider and taller threaded end and a smaller flat top disc. Note D Figs.1-3.

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e) The width of the edge of the flashlight head where the head meets the handle portion is much thinner than in the original Fig.1. Note E Figs.1 and 3.

7. The claim is again and FINALLY REJECTED under 35 U.S.C. § 103 as being unpatentable over Maglica patent no. 4,658,336 in view of Huang.

8. The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under 35 U.S.C. § 103 should be withdrawn.

Applicant's sole argument against the rejection in light of the prior art is that the Maglica and Huang patents do not qualify as a prior art references over the instant application. Since continuity has been denied for the instant application as far back as 09/04/84, the claimed design is properly rejected under 35 U.S.C. § 103 as being unpatentable over Maglica patent no. 4,658,336 in view of Huang.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

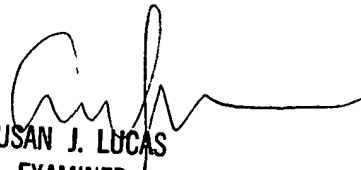
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10. Any inquiry concerning this communication should be directed to M. Tung at telephone number (703) 603-0505.

MMT  
M. Tung  
July 16, 1991

  
SUSAN J. LUCAS  
EXAMINER  
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